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SERIAL NUMBER	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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08/063,734 05/20/93 SIMONE

C	S4264.000P00
EXAMINER	

TEAM-EXAM FOUR

ART UNIT	PAPER NUMBER
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9

DICKSTEIN, SHAPIRO & MORIN
2101 L ST., NW
WASHINGTON, DC 20037

23M1/1227

2311
DATE MAILED:

12/27/94

This is a communication from the examiner in charge of your application.
COMMISSIONER OF PATENTS AND TRADEMARKS

☒ This application has been examined ☒ Responsive to communication filed on 10-12-94 ☒ This action is made final.

A shortened statutory period for response to this action is set to expire 3 month(s), — days from the date of this letter.
Failure to respond within the period for response will cause the application to become abandoned. 35 U.S.C. 133

Part I THE FOLLOWING ATTACHMENT(S) ARE PART OF THIS ACTION:

- | | |
|---|---|
| 1. <input type="checkbox"/> Notice of References Cited by Examiner, PTO-892. | 2. <input type="checkbox"/> Notice of Draftsman's Patent Drawing Review, PTO-948. |
| 3. <input type="checkbox"/> Notice of Art Cited by Applicant, PTO-1449. | 4. <input type="checkbox"/> Notice of Informal Patent Application, PTO-152. |
| 5. <input type="checkbox"/> Information on How to Effect Drawing Changes, PTO-1474. | 6. <input type="checkbox"/> _____ |

Part II SUMMARY OF ACTION

1. ☒ Claims 1-8 are pending in the application.
Of the above, claims _____ are withdrawn from consideration.
2. ☐ Claims _____ have been cancelled.
3. ☐ Claims _____ are allowed.
4. ☒ Claims 1-8 are rejected.
5. ☐ Claims _____ are objected to.
6. ☐ Claims _____ are subject to restriction or election requirement.
7. ☐ This application has been filed with Informal drawings under 37 C.F.R. 1.85 which are acceptable for examination purposes.
8. ☐ Formal drawings are required in response to this Office action.
9. ☐ The corrected or substitute drawings have been received on _____. Under 37 C.F.R. 1.84 these drawings are ☐ acceptable; ☐ not acceptable (see explanation or Notice of Draftsman's Patent Drawing Review, PTO-948).
10. ☐ The proposed additional or substitute sheet(s) of drawings, filed on _____, has (have) been ☐ approved by the examiner; ☐ disapproved by the examiner (see explanation).
11. ☐ The proposed drawing correction, filed _____, has been ☐ approved; ☐ disapproved (see explanation).
12. ☐ Acknowledgement is made of the claim for priority under 35 U.S.C. 119. The certified copy has ☐ been received ☐ not been received ☐ been filed in parent application, serial no. _____; filed on _____.
13. ☐ Since this application appears to be in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under Ex parte Quayle, 1935 C.D. 11; 453 O.G. 213.
14. ☐ Other

EXAMINER'S ACTION

Part III DETAILED ACTION

1. This Office Action is responsive to communication filed Oct. 10, 1994. Claims 1-8 remain pending.

Notice to Applicant

2. This application has been examined by a team of four Examiners as part of a pilot team-examining program within the U.S. Patent Office.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. § 103 which forms the basis for all obviousness rejections set forth in this Office action:

A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Subject matter developed by another person, which qualifies as prior art only under subsection (f) or (g) of section 102 of this title, shall not preclude patentability under this section where the subject matter and the claimed invention were, at the time the invention was made, owned by the same person or subject to an obligation of assignment to the same person.

Claims 1-8 are rejected under 35 U.S.C. § 103 as being unpatentable over DeTore et al. (4,975,840).

The reasons for this rejection remain the same as those given in the previous Office Action (Paper #7; section 4, pages 5-8).

Applicant's arguments filed October 12, 1994 have been fully considered but they are not deemed to be persuasive.

Applicant argues that DeTore only focuses on evaluating existing medical problems and not considering lifestyle data of an individual. In response, DeTore et al. discloses evaluating the insurability of a risk wherein each problem within a particular case is considered on a individual basis, including the lifestyle of an individual (see col. 12, line 37 to col. 13, line 16).

Applicant further argues that DeTore only evaluates risks as they pertain to life insurance, but cannot make determinations relevant to health insurance. In response, these limitations are not found in the claims. Claimed subject matter, not the specification is the measure of the invention. Disclosure contained in the specification can not be read into the claims for the purpose of avoiding prior art. *In re Spork*, 55 CCPA 743, 386 F.2d 924, 155 687 (1986).

Applicant lastly argues that DeTore fails to analyze and then provide a user with suggestion for improving his or her health condition. In response, DeTore provides messages or suggestions in the "TREATMENT" section for an individual having a

medical problem in hypertension and how to improve their health conditions (see cols. 19-22).

Claim Rejections - 35 USC § 101

4. 35 U.S.C. § 101 reads as follows:

"Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter or any new and useful improvement thereof, may obtain a patent therefore, subject to the conditions and requirements of this title".

Claims 1-8 are rejected under 35 U.S.C. § 101 because the claimed invention is directed to non-statutory subject matter--in particular, a method of doing business.

The reasons for this rejection remain the same as those stated in the previous Office Actions.

Applicant argues that claims 1-8 of the present invention all contain a general purpose computer specifically programmed to perform a "particular function", like those in *Alappat*.

(page 3, 1st paragraph of the 10/12/94 amendment).

In response, the Examiner notes that it was the specific programming disclosed by Alappat that the court held as the basis for their reasoning that a new machine was created. It was specifically stated that "We have held that such programming creates a new machine because a general purpose computer in effect becomes a special purpose computer once it is programmed to perform a particular functions pursuant to instructions from

program software." (emphasis added) *In re Alappat et al.*, supra. It is respectfully submitted that the above statement can not and should not be extrapolated to necessarily mean that any and every kind of computer programming for generating special data, in effect, creates a new process or machine. Whether or not subject matter is a "new machine" depends on whether or not the subject matter satisfies a careful analysis of the §101 issue according to Supreme Court §101 precedent. See *Johnson*, 502 F.2d 773, 183 USPQ 178-179.

The program in the present application does not make a machine which operates in an unconventional or unexpected manner, but merely applies general purpose architecture to a new field of endeavor. Therefore, the invention lies in the method of doing business rather than the computer system itself.

Applicant further states that the present invention is not a method of doing business and would be patentable because all claims disclose a computer system.

In response, it is the position of the examiner that evaluating insurability of an individual by gathering and storing information, assigning weight values to each information, determining a total value and providing a level of insurance risk are steps which fall within the penumbra of activities performed by insurance sales personnel and thus may be fairly characterized as a method of doing business.

The fact that these steps are carried out on a computer system does not automatically transform the claims into statutory subject matter. General purpose computers are simply tools in performing a business function in the same genre as pencil, paper, handheld calculator, etc. According to *In re de Castelet*, 569 F.2d 1236 (1977) "claims to non-statutory processes do not automatically and invariably become patentable upon incorporation of reference to apparatus." Further, a general purpose computer is not considered a specific apparatus distinct from other apparatus capable of performing the identical functions as required by *In re Walter*, 205 USPQ 397, 408. Thus, the recitation of a computer should not shroud the issues at hand; it is apparent from the specification that the inventive premise resides in a financial principle or technique rather than the apparatus claimed. On the basis, the recitation of computer hardware in a claim should be treated in the same light as other "de-mystified" business tools.

Conclusion

5. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 C.F.R. § 1.136(a).

A SHORTENED STATUTORY PERIOD FOR RESPONSE TO THIS FINAL ACTION IS SET TO EXPIRE THREE MONTHS FROM THE DATE OF THIS ACTION. IN THE EVENT A FIRST RESPONSE IS FILED WITHIN TWO MONTHS OF THE MAILING DATE OF THIS FINAL ACTION AND THE ADVISORY ACTION IS NOT MAILED UNTIL AFTER THE END OF THE THREE-MONTH SHORTENED STATUTORY PERIOD, THEN THE SHORTENED STATUTORY PERIOD WILL EXPIRE

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ON THE DATE THE ADVISORY ACTION IS MAILED, AND ANY EXTENSION FEE PURSUANT TO 37 C.F.R. § 1.136(a) WILL BE CALCULATED FROM THE MAILING DATE OF THE ADVISORY ACTION. IN NO EVENT WILL THE STATUTORY PERIOD FOR RESPONSE EXPIRE LATER THAN SIX MONTHS FROM THE DATE OF THIS FINAL ACTION.

6. The examiner responsible for this communication are Jennifer Hazard, Gita Shingala, Joseph Thomas and Stephen Tkacs.

Any inquiry concerning this communication or earlier communications from the examining team should be directed to the lead examiner, Gita Shingala, whose telephone number is (703) 305-9777. The lead examiner can normally be reached on Monday through Thursday from 7:00 AM to 4:00 PM. The lead examiner can also be reached on alternative Fridays.

If attempts to reach the lead examiner by telephone are unsuccessful, the examiners' supervisor, Gail Hayes, can be reached on (703) 305-9711. The fax phone number is (703) 305-9731.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 305-3800.

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December 22, 1994

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SRT
J.T.

David M. Huntley
DAVID M. HUNTLEY
PRIMARY EXAMINER
GROUP 2300